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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,329	09/16/2003	Hisashi Hotta	Q75433	9174

23373 7590 02/11/2005

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EXAMINER
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GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/662,329

Applicant(s)

HOTTA, HISASHI

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/17/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claims***

2. Claims 1-8 are present.
3. Claims 3-8 are product-by-process claims. Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1 300 257 A2.

a. Hotta et al. teach a presensitized printing plate comprising a support, a water receptive layer and a conventional positive type image forming layer with sufficient specificity. Specifically, Hotta et al. teach a support for lithographic printing plate obtainable by performing at least graining treatment on an aluminum plate, having on its surface thereof, a grain shape (abstract; [0065]-[0116]). The grain shape has a grain structure with large undulation of 5 to 100  $\mu\text{m}$  average wavelength, a grain structure with medium undulation of 0.5 to 5  $\mu\text{m}$  average aperture diameter, and a grain structure with small undulation of 0.01 to 0.2  $\mu\text{m}$  average aperture diameter. The average of ratios of depths to the aperture diameters with small undulation is 0.2 or more. ([0024]; (2), (3)). Preferably a water receptive layer of low thermal conductivity, 0.05 to 0.5 W/(m·K), is provided on the support ([0121]-[0124]). It is preferably a layer of highly hydrophilic aluminum oxide, formed by anodizing the aluminum plate surface ([0141]-[0157]). One of the preferred forms of the water receptive layer is either having the density of 1,000 to 3,200 kg/m<sup>2</sup>, or porosity of 20 to 70 % ([0163]-[0170]). A treatment for water wettability, preferably with an aqueous solution containing alkali metal silicates such as sodium silicate or potassium silicate, after anodizing or sealing treatment is performed ([0172]-[0177]). Various image forming layers, including conventional positive type image forming layers, can be prepared on the support ([0214]-[0219]).

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6. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by anticipated by Hotta et al. (US 2003/0165768 A1).

a. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

b. Hotta et al. teach a presensitized printing plate comprising a support, a water receptive layer and a conventional positive type image forming layer with sufficient specificity. Specifically, Hotta et al. teach a support for lithographic printing plate obtainable by performing at least graining treatment on an aluminum plate, having on its surface thereof, a grain shape (abstract; [0039]; [0106]-[0166]). The grain shape has a grain structure with large undulation of 5 to 100  $\mu\text{m}$  average wavelength, a grain structure with medium undulation of 0.5 to 5  $\mu\text{m}$  average aperture diameter, and a grain structure with small undulation of 0.01 to 0.2  $\mu\text{m}$  average aperture diameter. The average of ratios of depths to the aperture diameters with small undulation is 0.2 or more. ([0028]-[0029]). Preferably a water receptive layer of low thermal conductivity, 0.05 to 0.5 W/(m·K), is provided on the support ([0174]-[0179]). It is preferably a layer of highly hydrophilic aluminum oxide, formed by anodizing the aluminum plate surface ([0193]-[0208]). One of the preferred forms of the water receptive layer is either having the density of 1,000 to 3,200 kg/m<sup>2</sup>, or porosity of 20 to 70 % ([0215]-[0222]). A

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treatment for water wettability, preferably with an aqueous solution containing alkali metal silicates such as sodium silicate or potassium silicate, after anodizing or sealing treatment is performed ([0225]-[0233]). Various image forming layers, including conventional positive type image forming layers, can be prepared on the support ([0270]-[0277]).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

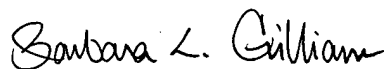
- a. In US 2003/0194642 A1, Kikuchi teach a thermal negative type presensitized plate (abstract).
- b. In US 2003/0165775 A1, Endo et al. teach a presensitized plate having an aluminum support (abstract).
- c. In US 6,716,567 B2, Endo et al. teach a supporting body for a lithographic printing plate (abstract)
- d. In US 6,730,455 B2, Matsumura teach a method of preparing planographic printing plate.
- e. In US 6,103,087, Mori teach a method for manufacturing a presensitized planographic printing plate (abstract).
- f. In US 5,837,345, Nishino et al. teach a support for lithographic printing plate having a corrugated surface (abstract).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

v. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
February 3, 2005